

REMARKS

Claims 19-45 are pending in the application. Claims 1-18 have been variously rejected under 35 U.S.C. §§ 102 and 103. Claims 1-18 have herein been cancelled without prejudice or disclaimer. Claims 19-45 have herein been added and are fully supported by the specification. No new matter has been added to the claims or prosecution of this application. For at least the reasons stated below, Applicant asserts that all claims are now in condition for allowance.

Claims 13-18 have been rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter for reciting logic. Applicant cancels claims 13-18 without prejudice or disclaimer. Applicant adds claims 37-45 with elements in means-plus-function form, thus rendering the rejection for reciting logic moot.

Claims 2, 5, 6, 8, 11, 12, 14, 17 and 18 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner states that these claims do not recite any additional method steps.

Applicant first notes that cancelled claims 8, 11, 12, 14, 17 and 18 did not depend from method claims, and therefore do not need to recite additional method steps.

Applicant adds new claims 24 and 27, depending from independent claim 19, to include language indicating that the claims add additional method elements to the independent claims from which they depend.

The present invention generally provides for tax form submittal verification, including the following elements:

receiving a tax form of a user by a third party government entity utilizing a network;

storing a record of the tax form in a database of the third party government entity, wherein the record represents an indication that the tax form has been submitted;

receiving from the user a request for the record of the tax form utilizing the network;

authenticating an identity of the user utilizing the network, wherein the identity is authenticated by requesting a password and a digital certificate from the user and validating the password and the digital certificate as belonging to the user; and

sending the record of the tax form to the user utilizing the network upon the successful authentication of the identity of the user.

The Examiner cited the User's Guide for TurboTax and TurboTax Deluxe (*TurboTax*) under 35 U.S.C. §§ 102 and 103 variously against cancelled claims 1-18. Applicant asserts that not every element of claims 19-45 is taught by *TurboTax*. Applicant further asserts that *TurboTax* cannot be combined with any reference to teach all of the elements of claims 19-45, and that therefore *TurboTax* cannot be used as a reference under either § 102 or § 103. Applicant therefore respectfully submits that claims 19-45 are in condition for allowance.

In Applicant's claims, a system and method is provided for obtaining verification of submittal of a tax form to a government entity. In other words, Applicant's invention provides the ability to verify, from the government entity, submission of a tax form. Applicant's invention teaches that a tax form is received by a third party government entity, and that a record of the tax form is stored in a database of the third party government entity. *TurboTax*, at pages 39-40, discusses steps in electronically filing a tax return. Tax returns submitted with *TurboTax* pass through Intuit's electronic filing center, and then are forwarded to the IRS. A user submitting a tax form must request a status of the filing from the Intuit Filing Center. The Intuit Filing Center advises the user of the status of the filing, including when the tax form is accepted by the IRS. However, there is no indication or suggestion in this process that a tax form is stored in a database of the IRS, since *TurboTax* communicates with the user only through the Intuit Filing Center. Therefore, *TurboTax* does not disclose that a record of the tax form is stored in a database of the third party

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government entity. Applicant respectfully submits that claims 19-45 are in condition for allowance.

Applicant's claims also teach that the identity of the user is authenticated utilizing the network, wherein the identity is authenticated by requesting a password and a digital certificate from the user and validating the password and the digital certificate as belonging to the user, and then sending the record once the user's identity is authenticated. The Examiner states that *TurboTax* teaches authentication of a user's identity using a modem. However, modems are used for dial-up network access and are not used to authenticate someone's identity. Applicant's claims require more security than a modem. They require the determination that an authorized user is accessing tax records. To this end, Applicant's claims now require that a password and digital certificate be requested and validated as belonging to an authorized user before a tax form submittal record is sent to the user. *TurboTax* does not teach that a password and digital certificate are needed to authenticate a user, or that any security system at all is used to identify users. Therefore, *TurboTax* does not teach this element of Applicant's claims, and Applicant submits that claims 19-45 are in condition for allowance.

The Examiner further states that the use of a digital certificate to validate a user's identity would have been obvious by modifying *TurboTax* with a digital certificate. Digital certificates are identification systems used for enhanced security purposes. A user cannot access the tax service server in Applicant's claims unless a properly-identifying digital certificate exists for that particular user. However, there is no teaching in *TurboTax* to suggest the use of a digital certificate with Intuit's tax service. *TurboTax*, as discussed above, does not employ any type of security system to determine or authenticate a user's identity. *TurboTax* simply discloses that a user is allowed to retrieve a status of his or her filed tax form using a modem. This provides no security for a user's identity and tax information. Therefore, *TurboTax* actually teaches away from the use of a digital certificate and away from a security mechanism in general, since there is no disclosed method of

authenticating a user's identity. Since the reference itself must provide some teaching whereby the applicant's combination would have been obvious, and since no such suggestion is present here with the reference cited by the Examiner, Applicant submits that it would not have been obvious under 35 U.S.C. § 103 to combine Applicant's invention with a digital certificate.

Applicant further notes that Examiner based rejections of the some claims on the assertion that the use of digital certificates is common in the art. Applicant respectfully traverses these rejections. According to MPEP Section 2144.03, and In re Ahlert, 424 F.2d 1088, 1091, assertions of technical fact in areas of esoteric technology must always be supported by citation, and the burden is on the Examiner to cite to specific references unless he or she is capable of instant and unquestionable demonstration for official notice of facts outside of the record which are stated to be well-known in the art. Applicant believes *See 713/156* that in the realm of network-based information processing, the use of a digital certificate is of such a technical nature that references are required in support of rejections. If the Examiner still does not find the claims in condition for allowance based on the above arguments, Applicant requests that the Examiner provide an affidavit or cite a reference in support of the position concerning digital certificates in accordance with MPEP Section 2144.03.

Applicant's newly-added claims 19-45 include dependent claims disclosing receiving a tax payment of the user by the third party government entity, storing a record of the tax payment in the database of the third party government entity, receiving from the user a request for the record of the tax payment, and sending the record of the tax payment to the user utilizing the network upon the successful authentication of the identity of the user. None of these elements are disclosed in *TurboTax*. In *TurboTax*, users submitting electronic tax forms must separately mail their payments in to the IRS. There is no mechanism for electronically receiving a tax payment, for storing a record of the tax payment, for receiving a request for the record of the tax payment, or for sending the record of the tax payment to

the user. Furthermore, there is no suggestion to combine *TurboTax* with any other reference to produce these claimed features, since there is no disclosure in *TurboTax* of storing a record of anything electronically submitted in a database of a third party government entity, or for authenticating a user's identity for the purposes of sending the record. Applicant therefore respectfully submits that these dependent claims are in condition for allowance.

CONCLUSION

Applicant submits that all pending claims are allowable and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 310-788-5055. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Reference 60021-357601).

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE TITLE

Please amend the title as follows:

[SYSTEM, METHOD AND ARTICLE OF MANUFACTURE FOR] VERIFICATION AND
PRINTING OF A TAX RETURN IN A NETWORK-BASED TAX ARCHITECTURE

IN THE CLAIMS

Please cancel claims 1-18 without prejudice or disclaimer.

Please add claims 19-45 as follows:

19. (Newly Added) A method for tax form submittal verification comprising:
 - receiving a tax form of a user by a third party government entity utilizing a network;
 - storing a record of the tax form in a database of the third party government entity, wherein the record represents an indication that the tax form has been submitted;
 - receiving from the user a request for the record of the tax form utilizing the network;
 - authenticating an identity of the user utilizing the network, wherein the identity is authenticated by requesting a password and a digital certificate from the user and validating the password and the digital certificate as belonging to the user; and
 - sending the record of the tax form to the user utilizing the network upon the successful authentication of the identity of the user.
20. (Newly Added) The method of claim 19, further comprising receiving a tax payment of the user by the third party government entity utilizing the network.
21. (Newly Added) The method of claim 20, further comprising storing a record of the tax payment in the database of the third party government entity, wherein the record represents an indication that the payment has been submitted.

22. (Newly Added) The method of claim 21, further comprising receiving from the user a request for the record of the tax payment utilizing the network.

23. (Newly Added) The method of claim 22, further comprising sending the record of the tax payment to the user utilizing the network upon the successful authentication of the identity of the user.

24. (Newly Added) A method as recited in claim 19, wherein the sending a tax form of a user to a third party government entity utilizing a network includes the Internet.

25. (Newly Added) A method as recited in claim 19, and further comprising the step of formatting the record for being printed by the user.

26. (Newly Added) A method as recited in claim 19, and further comprising the step of sending a notification relating to the record to a mail server of the user utilizing the network.

27. (Newly Added) A method as recited in claim 19, wherein the authenticating an identity of the user includes storing the digital certificate on a computer of the user.

28. (Newly Added) A computer program embodied on a computer readable medium for tax form submittal verification comprising:

a code segment that receives a tax form of a user to a third party government entity utilizing a network;

a code segment that stores a record of the tax form in a database of the third party government entity, wherein the record represents an indication that the tax form has been submitted;

a code segment that receives from the user a request for the record of the tax form utilizing the network;

a code segment that authenticates an identity of the user utilizing the network, wherein the identity is authenticated by requesting a password and a digital certificate from the user and validating the password and the digital certificate as belonging to the user; and

a code segment that sends the record of the tax form to the user utilizing the network upon the successful authentication of the identity of the user.

29. (Newly Added) A computer program as recited in claim 28, and further comprising a code segment that receives a tax payment of the user by the third party government entity utilizing the network.

30. (Newly Added) A computer program as recited in claim 29, and further comprising a code segment that stores a record of the tax payment in the database of the third party government entity, wherein the record represents an indication that the payment has been submitted.

31. (Newly Added) A computer program as recited in claim 30, and further comprising a code segment that receives from the user a request for the record of the tax payment utilizing the network.

32. (Newly Added) A computer program as recited in claim 31, and further comprising a code segment that sends the record of the tax payment to the user utilizing the network upon the successful authentication of the identity of the user.

33. (Newly Added) A computer program as recited in claim 28, wherein the network includes the Internet.

34. (Newly Added) A computer program as recited in claim 28, and further comprising a code segment that formats the record for being printed by the user.

35. (Newly Added) A computer program as recited in claim 28, and further comprising a code segment that sends a notification relating to the record to a mail server of the user utilizing the network.

36. (Newly Added) A computer program as recited in claim 28, wherein the digital certificate is stored on a computer of the user.

37. (Newly Added) A system for tax form submittal verification comprising:
means for receiving a tax form of a user by a third party government entity utilizing a network;

means for storing a record of the tax form in a database of the third party government entity, wherein the record represents an indication that the tax form has been submitted;

means for receiving from the user a request for the record of the tax form utilizing the network;

means for authenticating an identity of the user utilizing the network, wherein the identity is authenticated by requesting a password and a digital certificate from the user and validating the password and the digital certificate as belonging to the user; and

means for sending the record of the tax form to the user utilizing the network upon the successful authentication of the identity of the user.

38. (Newly Added) A system as recited in claim 37, and further comprising a code segment that receives a tax payment of the user by the third party government entity utilizing the network.

39. (Newly Added) A system as recited in claim 38, further comprising means for storing a record of the tax payment in the database of the third party government entity, wherein the record represents an indication that the payment has been submitted.

40. (Newly Added) A system as recited in claim 39, further comprising means for receiving from the user a request for the record of the tax payment utilizing the network.

41. (Newly Added) A system as recited in claim 40, further comprising means for sending the record of the tax payment to the user utilizing the network upon the successful authentication of the identity of the user.

42. (Newly Added) A system as recited in claim 37, wherein the network includes the Internet.

43. (Newly Added) A system as recited in claim 37, further comprising means for formatting the record for being printed by the user.

44. (Newly Added) A system as recited in claim 37, further comprising means for sending a notification relating to the record to a mail server of the user utilizing the network.

45. (Newly Added) A system as recited in claim 37, wherein the digital certificate is stored on a computer of the user.